

REMARKS/ARGUMENTS

Applicants request reconsideration of the objection to claim 18 due to certain informalities. Applicants have amended claim 18 in the manner suggested by the Examiner. In view of these amendments, it is believed that the objection to claim 18 may now be withdrawn.

Applicants request reconsideration of the objections to the disclosure. With respect to the Examiner's position that the language of the claims and the specification are not consistent, Applicants point out that at various places in the specification screens, displays, and pages are used interchangeably. In view of this, it is believed that there are no inconsistencies between the specification and the claim language. With respect to the objection to the paragraph that begins on line 8, at page 11, of the specification, Applicants have amended the identification of the boxes 116-122 to be boxes 116, 118, 120, and 122. Applicants believe that the specification was clear that there was no reference to numerals or elements 117, 119, and 121. However, in order to clarify the specification and overcome the objection Applicants have amended the specification in the manner suggested by the Examiner. It is believed that the objections to the disclosure should now be withdrawn.

Applicants request reconsideration of the rejection of claims 18-20 under 35 U.S.C. §102(e) as being anticipated by Thean et al., U.S. Patent No. 6,397,036. In order to establish a *prima facie* case of anticipation a reference must disclose every element of the claim. See *Scripps Clinic & Res. Found. V. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 19910; *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

The absence from the reference of any claimed element negates anticipation. See *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986). The Examiner has failed to show where in the Thean et al. reference there is disclosed all three levels of control as claimed by the Applicants. In particular, the second level and the third level of control, as claimed by the Applicants, are not shown in the Thean et al. reference. The Examiner has also stated that Applicants' invention "requires" the use of software from Placeware. However, the specification only indicates that Placeware software is an example of a software program that may be used. Further, the Examiner has not shown how it is inherent that the same software will include the different levels of control. In view of this, the Examiner has not established a *prima facie* case of anticipation based on the Thean et al. reference. The rejection of claims 18-20 under 35 U.S.C. §102(e) as being anticipated by Thean et al. should be withdrawn.

Applicants request reconsideration of the rejection of claims 1, 3-4, 7-9, 11-12, and 16-17 under 35 U.S.C. §103(a) as being unpatentable over D'Agostino in view of Thean et al. As has been previously stated in a prior response, in rejecting claims under 35 U.S.C. §103, it is incumbent upon the Examiner to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion, or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Sernaker*, 702

F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the Applicants' disclosure as his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole obvious under 35 U.S.C. §103. *Panduit v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), vacated 475 U.S. 809, 229 USPQ 478 (1986), aff'd on remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987). It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims in the application would not have made the modification obvious unless the prior art suggests the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

With respect to claims 1 and 9, the Examiner takes the position that it would have been obvious to transform the enabled program into a web enabled program to see visual portions of streaming video. However, the Examiner has not pointed out where in the prior art that there is a suggestion of the desirability of such a modification. As has been discussed in a previous response, D'Agostino is a dedicated self-contained system in which the customer terminal is only connected to a representative terminal. There is no discussion or suggestion in D'Agostino for any other system. Further, D'Agostino specifically states that the customer does not operate the customer terminal. See Column 7, lines 65-66 of the D'Agostino reference. With such a disclosure, there would be no reason to modify D'Agostino in the manner suggested by the Examiner. There is also no disclosure that computer 14, as identified in the D'Agostino reference, is able to access the Internet as the Examiner suggests in page 6 of the Office Action. It appears that

D'Agostino stands for the proposition that the computer 14 can only be connected to a representative terminal.

Applicants also point out that claims 1 and 9 have been amended to include the patentable feature of the controlling means comprising different levels of control with a first level of control being the computer system sending screens to the computer with the computer system being capable of viewing different screens. Neither D'Agostino nor Thean et al. teach or suggest such a construction. D'Agostino teaches that the same screen that appears on the customer terminal appears on the representative terminal. In view of the amendment to claims 1 and 9, the base independent claims, it is submitted that claims 1 and 9 are allowable and all of the dependent claims are allowable for the same reasons.

Regarding the rejection of claims 4 and 12, the Examiner takes the position that it would have been obvious to send an audio file, a video clip, or a slide show over the system shown in D'Agostino in view of the disclosure of Thean et al. However, again, Applicants point out that the Examiner has not pointed out where in the prior art that there is a suggestion of the desirability of such a modification. D'Agostino only discloses being capable of displaying predetermined financial forms from the representative terminal to the customer terminal. In view of this, the rejection of claims 4 and 12 should be withdrawn.

In rejecting claim 7, the Examiner only states that a representative is capable of inputting information to be displayed on the computer capable of accessing an Internet. First, the Examiner has not indicated in which prior art reference such is found. Second, claim 7 is claiming, "another level of control is the controlling means controlling

operation of the web enabled program to navigate about the web site". Applicants do not understand why claim 7 is being rejected. In particular, it appears that the Examiner has misread the claim language.

With respect to the rejection of claims 8 and 17, the Examiner has again misread the claim language. The claim language is "a first window which is representative of a screen being provided to the computer and a second window containing other information, the first window and the second window being displayed simultaneously in the display". The first and second windows are displayed in the same display. The section cited by the Examiner, column 13, line 68 to column 14, line 2, states that the screen that appears on display 24 of the customer terminal also appears on the display of the representative terminal. Clearly what is being claimed is different from what the Examiner has pointed to in the D'Agostino reference.

The Examiner states, in rejecting claim 16, that it would have been obvious to place a web site in the vendor computer system of D'Agostino to demonstrate services or products for sale. Applicants point out that the Examiner has not pointed out where in the prior art that there is a suggestion of the desirability of such a modification. D'Agostino only discloses a dedicated system. In view of this, the rejection of claim 16 should be withdrawn.

Again, in view of the amendment to claims 1 and 9, the base independent claims, it is submitted that claims 1 and 9 are allowable and all of the dependent claims are allowable for the same reasons. The rejection of claims 1, 3-4, 7-9, 11-12, and 16-17 under 35 U.S.C. §103(a) as being unpatentable over D'Agostino in view of Thean et al. should now be withdrawn.

Applicants request reconsideration of the rejection of claims 5-6 and 13-15 under 35 U.S.C. §103(a) as being unpatentable over D'Agostino in view of Thean et al. and further in view of Szymansky, U.S. Patent No. 6,557,029, a patent which issued well after the filing date of Applicants' application. With respect to the rejection of claims 5 and 13, the Examiner has taken the position that D'Agostino does not disclose a wireless connection but that wireless connections have been known for years in view of the disclosure in Szymansky and it would have been obvious to convert the telephone connection 16 of D'Agostino into a wireless connection. Further, with respect to the rejection of claims 6, 14, and 15, the Examiner states that a hand held computer was known in view of the disclosure of Szymansky and that it would have been obvious to replace the computer disclosed in the D'Agostino reference with a hand held computer.

The Examiner's reasoning is faulty on two counts. First, as stated above, there must be some reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion, or inference in the prior art as a whole. There is simply no reason to combine the prior art in the manner suggested by the Examiner. For example, the D'Agostino reference does not teach or suggest a wireless connection or a hand held computer and none of the other references cited by the Examiner teach or suggest the desirability of making such a modification to the D'Agostino reference. D'Agostino, as the Examiner has acknowledged, does not teach or suggest the desirability of using a wireless connection or a hand held computer. Absent some teaching, suggestion, or inference in the prior art, the §103 rejection is improper.

Second, it is impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. *Grain Processing Corp. v. American Maize-Products Corp.*, 5 USPQ2d 1788, 1792, (Fed. Cir. 1988); *American Medical Systems Inc. v. Medical Engineering Corp.*, 26 USPQ2d 1081, 1091 (E.D. Wis. 1992), *aff'd in part, rev'd in part & remanded*, 28 USPQ2d 1321 (Fed. Cir. 1993). A rejection based on 35 U.S.C. §103 must rest on a factual basis. The U.S. Patent and Trademark Office has the initial duty to supply the factual basis for such a rejection. It may not, because it may doubt an invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in its factual basis. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). The Examiner has apparently relied on hindsight, based on having Applicants' disclosure before him, in concluding that it would have been obvious to use a wireless connection or a handheld computer. As recognized by the Examiner, D'Agostino is completely devoid of any suggestion, teaching, or inference concerning use of a wireless connection or a handheld computer. As the courts have frequently warned the use of "hindsight" in determining obviousness is improper. In the case of *In re Manurkar Patent Litigation*, 28 USPQ2d 1801 (N.D. Ill. 1993), Judge Easterbrook stated that "decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden ex post analysis."

Further, Judge Easterbrook stated *Id.* at 1817:

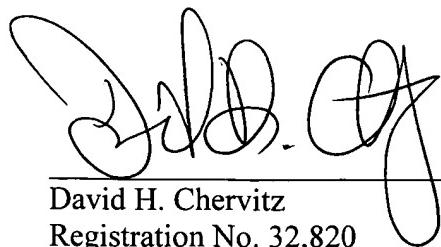
With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. ... Unless the prior art itself suggest the particular combination, it does not show that the actual invention was obvious or anticipated.

The Examiner has attempted to piece together an obvious rejection having Applicants' disclosure in front of him. In particular, the Examiner leaps from a low cost microcomputer to a PDA and states that a PDA qualifies as a low cost microcomputer without any citation for this position. Another leap is made to the Szymansky reference. However, there is no reason why one having ordinary skill in the art would combine the references in the manner suggested by the Examiner.

It is only with the Applicants' disclosure that the Examiner can conclude that it would have been obvious to use a wireless connection or a hand held computer. Therefore, it would not have been obvious to use a wireless connection or a hand held computer in D'Agostino. Further, Applicants have amended claims 1 and 9, the base independent claims from which claims 5, 6, 13, 14, and 15 depend. Claims 1 and 9 were shown to be allowable above and the dependent claims are allowable for the same reasons. In view of the above amendments, remarks, and cited case law, it is believed that the rejection of claims 5, 6, 13, 14, and 15 under 35 U.S.C. §103 as being unpatentable over D'Agostino in view of Thean et al. and further in view of Szymansky should be withdrawn.

Applicants submit that upon entry and review of the amended claims and consideration of the above remarks this application should be in condition for allowance. In the event that this application is for any reason not considered by the Examiner to be in form for allowance, Applicants' counsel requests the Examiner to telephone the undersigned before issuing a further action to discuss any objections the Examiner might have, thereby simplifying and expediting the examination and prosecution process.

Respectfully submitted,



David H. Chervitz
Registration No. 32,820
POLSTER, LIEDER, WOODRUFF
& LUCCHESI, L.C.
12412 Powerscourt Drive, Suite 200
St. Louis, Missouri 63131-3615
(314) 238-2400